

RECEIVED
CENTRAL FAX CENTER

MAY 01 2007

Appl. No. 10/776,150
Reply to Office Action of March 1, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

REMARKS

Claims 1-25 are pending in this application. In view of the following remarks, reconsideration is respectfully requested.

Comment Regarding Power of Attorney

The Power of Attorney for this application does not happen to identify the undersigned attorney. In filing this Response, the undersigned is acting under the provisions of 37 C.F.R. §1.34.

Inconsistency in the Office Action

Noted with appreciation is the indication on page 7 of the Office Action that dependent Claims 4-9, 15-17 and 22 are all directed to allowable subject matter, and would be allowed if rewritten in independent form.

On page 3, the Office Action indicates that these same claims are all rejected under 35 U.S.C. §101, on the ground that they fail to recite statutory subject matter. However, Claims 4-9, 15-17 and 22 cannot be both allowable and rejected. Given this inconsistency, it is respectfully submitted that the Office Action is improper, and must be withdrawn.

Premature Finality

Applicants respectfully traverse the finality of the Office Action. More specifically, MPEP 706.07(a) specifies that an Office Action shall not be final "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement".

The most recent prior Office Action (mailed on September 20, 2006) indicated that dependent Claims 4-9, 15-17 and 22 are all directed to allowable subject matter. As noted above, the present Office Action indicates that these claims are still allowable, while also indicating that they are all rejected under 35 U.S.C. §101. Although Applicants' last Response amended the independent claims from which Claims 4-9, 15-17 and 22 depend, those amendments had the effect of slightly narrowing Claims 4-9, 15-17 and 22. If Claims 4-9, 15-17

Appl. No. 10/776,150
Reply to Office Action of March 1, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

and 22 were previously allowable, then slightly narrowed versions of them would also necessarily be allowable. To the extent the Examiner may now be withdrawing the allowance of these claims in order to apply a new ground of rejection under §101, that new ground of rejection is not necessitated by the claim amendments made by Applicants. Accordingly, the present Office Action cannot properly be designated as a "final" rejection. It is therefore respectfully submitted that the finality of the pending Office Action is improper and must be withdrawn, and notice to that effect is respectfully requested.

Objection to the Specification

The Office Action objects to the specification, on the ground that the specification does not include a "summary of the invention" section. This ground of objection is respectfully traversed. There is no requirement for a "summary of the invention" in the patent statute, the rules, or the MPEP. The applicable statutory section (35 U.S.C. §112, first paragraph) requires only that the specification include a written description that is enabling and that discloses Applicants' best mode of practicing the invention. No mention is made in §112 of any requirement for a summary. Although a summary is mentioned in MPEP §608.01(a) as part of a "preferred" style for the specification, it is clearly permissive rather than required. MPEP §608.01(a) even indicates that it is permissible for Applicants to optionally include a sub-heading such as "Brief Summary of the Invention", followed simply by the words "Not Applicable" and no other text. For these reasons, it is respectfully submitted that the Examiner's objection to the absence of a summary section is without basis, and must be withdrawn.

The Rejection of Claims 1-25 Under §101 Constitutes Clear Error

The Office Action indicates that Claims 1-25 are rejected under 35 U.S.C. §101 on the ground that they are not directed to statutory subject matter. However, this rejection is respectfully traversed. In rejecting independent claims 1, 12, 20 and their associated dependent claims, the Office Action relies on *Diamond v. Diehr*, 450 U.S. 175 (1981) and *Gottschalk v. Benson*, 409 U.S. 63 (1972). *Diehr* and *Benson*, however, have been superseded by more recent cases, including *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995), and *State Street Bank v.*

Appl. No. 10/776,150
Reply to Office Action of March 1, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

Signature Financial Group, 149 F.3d at 1368, 1373-74, 47 USPQ2d at 1596, 1601-02 (Fed. Cir. 1998).

Under *In re Beauregard*, and as explained in MPEP §2106.01(I), claims reciting "A computer-readable medium having computer-executable instructions for performing a method" are statutory subject matter. Independent claim 20 is a Beauregard-style claim, reciting "A computer readable medium comprising computer executable instructions" which perform a method. Claims 21-25 depend from and further limit claim 20. Since Beauregard-style claims are automatically statutory subject matter under §101, the rejection of claims 20-25 constitutes clear error.

Turning to Claims 1-19, MPEP §2106(II)(A) acknowledges that *State Street* is a leading case, explaining that:

The claimed invention as a whole must >be useful and< accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at *1373-74<, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value[.]

Claims 1 and 12 recite a method and system, respectively, that enforce "policies and permissions to control access to various network resources." Without limiting the claim scope, Applicants point out that one example of such a method or system involves preventing a computer system user from accessing and using a networked printer (where the printer is an exemplary "network resource"). This is a "real-world," "useful, concrete and tangible result" as required by *State Street*, MPEP §2106 and 35 U.S.C. §101. Consequently, the rejection of Claims 1-19 under §101 constitutes clear error.

The Examiner's Rejection of Claims Under §103(a) Constitutes Clear Error

Claims 1-3, 10-14, 18-21 and 23-25 are each rejected under 35 U.S.C. §103 based on a proposed combination of Harsham U.S. Pat. No. 6,041,347, and Nguyen U.S. Patent Application

Appl. No. 10/776,150
Reply to Office Action of March 1, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

Publication No. 2003/0172145 A1. This rejection is respectfully traversed, for the following reasons.

THE REFERENCES, EVEN WHEN COMBINED, DO NOT TEACH ALL ELEMENTS OF THE CLAIMED INVENTION

MPEP §2143 provides "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Independent Claims 1, 12 and 20 of the present application recite creating "a set of mapped independent rule blocks" if an access control list is not empty. Paragraph 8 of the final Office Action asserts that this limitation is taught by Harsham, at col. 4, lines 25-28. The cited text in Harsham, however, states "[a]ccordingly, in the present invention, various logical groups of individual machines and groups of machines in the computer network may be defined" (Harsham, col. 4, ll. 25-18). Even a broad interpretation of the cited section of Harsham does not appear to teach "rule blocks" that are "mapped," "independent" or in a "set." The Office Action applies no other reference, including Nguyen, teaching this claim term. Thus, Harsham and Nguyen do not teach or suggest all the claim limitations as required by MPEP §2143, even when combined in the manner suggested by the Examiner. Thus, rejecting Claims 1, 12 and 20 based on Harsham in view of Nguyen constitutes clear error.

In addition, claims 1, 12 and 20 of the present application recite "creating a new independent rule block" and inserting a rule therein if the associated list is empty. Paragraph 8 of the final Office Action asserts that this limitation is taught by Nguyen at page 15, paragraph [0434]. The cited text in Nguyen, however, states:

Another consideration may be: is the design to include a router Access Control List (ACL) and packet filters? Many ISPs choose to omit firewalls and implement router ACL and packet filters instead. Considerations on whether to implement a firewall or router ACL and packet filters may include one or more of, but are not limited to, the following: routers are stateless and do not

Appl. No. 10/776,150
Reply to Office Action of March 1, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

examine payload, and firewalls are necessary for stateful applications.

Applicants submit that there isn't any reasonable interpretation of the provided citation that teaches "creating a new independent rule block," "inserting," or conditions the insertion on the emptiness of a "list." Paragraph 8 of the final Office Action admits that Harsham doesn't teach this claim term. Thus, Harsham and Nguyen do not teach or suggest all the claim limitations as required by MPEP §2143, even when combined in the manner suggested by the Examiner. Thus, rejecting Claims 1-3, 10-14, 18-21 and 23-25 based on Harsham in view of Nguyen constitutes clear error.

THE HARSHAM AND NGUYEN REFERENCES TEACH AWAY FROM EACH OTHER

MPEP §2145 X(D)(2) provides that: "It is improper to combine references where the references teach away from their combination." (Quoting *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). The final Office Action suggests that Harsham and Nguyen should be combined because Nguyen states that "all types of providers must position themselves for growth and agility to handle increasing numbers of subscribers, additional services, and workloads that are more challenging" (Nguyen at page 3, paragraph [0030], final Office Action at paragraph 8). However, Nguyen and Harsham give opposite prescriptions as to how to solve problems of growth and scalability.

Specifically, Nguyen states that early ISPs were not able to "scale their systems capacity" because they "combined the few required applications onto a single server" and pursued a "monolithic architecture design," and Nguyen proposes a distributed architecture. Nguyen at paragraph [0005], abstract. In contrast, Harsham states that "management of very large computer networks that are geographically dispersed is a difficult task" and prescribes a "centralized computer network management system." Harsham, col 1, ll. 39-41, 48-50.

Thus Harsham teaches against Nguyen's distributed system, and Nguyen teaches against Harsham's centralized system. Because Harsham and Nguyen have diametrically opposed prescriptions for achieving the purported result of greater "growth and agility," the Examiner's

Appl. No. 10/776,150
Reply to Office Action of March 1, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

suggestion to combine these references under §103 in order to achieve this result is improper under MPEP §2145 X(D)(2), and constitutes clear error.

For each of the foregoing reasons, it is respectfully submitted that Claims 1-3, 10-14, 18-21 and 23-25 are not rendered obvious under §103 by the proposed combination of Harsham and Nguyen, and notice to that effect is respectfully requested.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

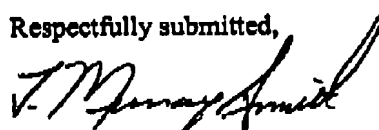
Although Applicants believe that no fees are due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this

Appl. No. 10/776,150
Reply to Office Action of March 1, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone
LLP.

Respectfully submitted,



T. Murray Smith
Registration No. 30,222
(972) 739-8647

Date: May 1, 2007

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: (972) 739-8647
Facsimile: (214) 200-0853
File: 26530.94

Enclosures: None

R-165854.1